THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 57

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MASAYA OKAMOTO

Junior Party,[1]

v.

JAMES M. SILVA and ROBERT A. PYLES

Senior Party.[2]

Interference No. 103,732

FINAL HEARING: January 29, 1998

CALVERT, SOFOCLEOUS, and HANLON, Administrative Patent Judges.

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[1] Application No. 07/231,151, filed August 11, 1988, now U.S. Patent No. 4,997,903, issued March 5, 1991. Assignor to Atomize Petrochemical Co. Ltd., A Corp. of Japan.

[2] Application No. 08/500,586, filed July 11, 1995. Accorded Benefit of U.S. Application Nos. 07/504,816, filed April 5, 1990, now Patent No. 5,464,930, issued November 7, 1995; 07/128,848, filed December 4, 1987, now Patent No. 5,011,967, issued April 30, 1991; and 06/917,751, filed October 10, 1986, now Patent No. 4,737,573, issued April 12, 1988. Assignor to the General Electric Co.

SOFOCLEOUS, Administrative Patent Judge.

FINAL DECISION

The subject matter of this interference relates to an optical disk substrate formed of a polycarbonate resin. The count of this interference is as follows:

Count 2

An optical disk substrate formed of a polycarbonate resin represented by the general formula

C_6H_5-$C(CH_3)_2$-C_6H_4-O-C(O)-[O-ϕ-Y-ϕ-O-C(O)-]$_n$O-C_6H_4-$C(CH_3)_2$-C_6H_5,

wherein ϕ is a phenylene radical and Y is a divalent radical in which one or two atoms separate the two ϕ units bonded thereto, and n is a positive integer.

The party Okamoto's claims 1 to 7 and the party Silva et al.'s claims 21 and 22 correspond to count 2.

This interference is related to Interference No. 103,272 which involves the same Okamoto patent. Since we held in that interference that the party Okamoto is not entitled to its claims 1 to 7, this interference is moot. However, for the sake of completeness in the event of an appeal of the decision in Interference No. 103,272, we deem it necessary to decide this interference.

In his Decision on Preliminary Motions, the Administrative Patent Judge (APJ) granted, inter alia, the party Okamoto's preliminary motion for judgment on the ground that there is no interference-in-fact. The party Silva et al. opposed this motion. After granting the motion, the APJ notified the parties that judgment would be entered

stating that each party is entitled to its claims corresponding to the count. In response to the notification, the party Silva et al. requested final hearing to review the decision granting the motion. The party Silva filed a record; both parties filed briefs, and appeared, through counsel, at final hearing.

The only issue before us is whether there is an interference-in-fact.

INTERFERENCE-IN-FACT

We hold that an interference-in-fact does not exist.

An APJ's decision on a preliminary motion constitutes an interlocutory order. 37 CFR § 1.601(q). The interlocutory order is presumed to have been correct and the party attacking the order, here the party Silva, has burden of showing error or abuse of discretion on the part of the APJ. 37 CFR § 1.655(a); Gustavsson v. Valenti, 25 USPQ2d 1401, 1405-06, (Bd. Pat. App. & Int. 1991) and Suh v. Hoefle, 23 USPQ2d 1321, 1326 (Bd. Pat. App. & Int. 1991). An abuse of discretion occurs if the decision (i) is clearly unreasonable, arbitrary, or fanciful; (ii) is based on an erroneous conclusion of law; (iii) rests on clearly erroneous fact findings; or (iv) involves a record that contains no evidence on which the APJ could rationally base his or her decision. Abrutyn v. Giovanniello, 15 F.3d 1048, 1050-51, 29 USPQ2d 1615, 1617 (Fed.Cir. 1994).

The test for interference-in-fact is set forth in 37 CFR § 1.601(n), which provides that an invention "A" is a separate patentable invention with respect to invention

"B" when invention "A" is new (35 U.S.C. § 102) and non-obvious (35 U.S.C. § 103) in view of invention "B," assuming invention "B" is prior art with respect to invention "A."

In holding that an interference-in-fact did not exist, the APJ agreed with the party Okamoto that the molecular weight range recited in its claims is critical and gives unexpected results, i.e., optical disks having molecular weights below or above the range recited in the party Okamoto's claims did not possess a combination of the desired impact strength and low birefrigence as shown by the data in the Tables found in columns 6 and 7 of the Okamoto patent. The party Silva did not challenge this data in any way.

In its brief, the party Silva et al. contends that the party Okamoto's claims define and embrace two different patentable inventions, whereas the two inventions were made by different entities at General Electric, one by party Silva et al. (this interference) and the other by Heuschen (Interference No. 103,272). This, however, is not considered a reason for holding that an interference-in-fact exists.

As we noted above, the test for interference-in-fact is set forth in 37 CFR § 1.601(n). After considering the evidence, the APJ agreed with the party Okamoto that it had made a sufficient showing, which the party Silva et al. does not dispute, that the party Okamoto's claims are novel and nonobvious over the party Silva et al.'s claims, assuming that the party Silva et al.'s claims were prior art. Nowhere in the brief has the party Silva et al. shown where the APJ's decision constitutes an abuse of discretion.

For the foregoing reasons, we hold that the party Silva et al. has not sustained its burden to show that there is an interference-in-fact.

JUDGMENT

An interference-in-fact does not exist. Accordingly, on the present record, Masaya Okamoto, the junior party, is not entitled to a patent containing claims 1 to 7, having lost those claims in Interference No. 103,272; and James M. Silva and Robert A. Pyles, the senior party, are entitled to a patent containing claims 21 and 22.

IAN A. CALVERT Administrative Patent Judge	)	
MICHAEL SOFOCLEOUS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ADRIENE LEPIANE HANLON Administrative Patent Judge	)	

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